



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/824,298

04/14/2004

Haimanot Bekele

9211M

6061

7590 05/13/2008
James J. Napoli, Ph.D.
Marshall, Gerstein & Borun LLP
233 South Wacker Drive
6300 Sears Tower
Chicago, IL 60606-6357

EXAMINER

PAGONAKIS, ANNA

ART UNIT

PAPER NUMBER

1614

MAIL DATE

DELIVERY MODE

05/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/824,298	Applicant(s) BEKELE ET AL.	
	Examiner ANNA PAGONAKIS	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 16-24 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 16, 17 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1 sheet, 2/4/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's Amendment filed on 2/4/2008 has been received and entered into the present application.

Claims 1-11, 16-24 remain currently pending. Claims 1, 5, 7, 16-17 are currently amended. Claims 12-15 are cancelled. Claims 18-24 have been added. Newly submitted claim 18-19 directed to a species that is independent or distinct from the invention originally claimed for the following reasons: Applicant has already elected a specific specie of glycerol, glyceryl ether, thus newly added claims 18-19 are withdrawn from consideration. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-19 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 1-11, 16-17, 20-24 remain currently under examination.

Applicant's arguments, filed 2/4/08, have been fully considered. Rejections not reiterated from the previous Office Action is hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

Information Disclosure Statement

Applicant's newly submitted Information Disclosure Statement filed on has been received. The cited reference is not being considered because it is not in the English language. Examiner notes that the abstract is also not in the English language.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6, 9, 10-11, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Sheehan (US Patent 4,795,631).

Sheehan teaches lip-film formulations which provide a thin, flexible, water-resistant film when applied to the lips, the lip-film thus formed being long-wearing and not smearing. The lip film composition comprises a film forming resin, which are copolymers of acrylic acid, methacrylic acid and acrylate or methacrylate esters (col. 2, lines 30-40), a volatile base in sufficient quantity to solubilize the resin and a plasticizer which render the film flexible without reducing its water resistance. In particular, example XI discloses a cosmetic composition hydrophilic copolymers (carbaset), glycerin (where glycerin is equivalent to glyceryl ether, Mesh Data attached), alcohol and water. Further, the reference teaches the addition of iron oxide as a pigment in the composition (column 4, first paragraph).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-11, 16-17, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheehan (US Patent 4,795,631), as applied above to claims 1, 2, 6, 9, 10-11, 21, in view of Holguin et al (US 6,706,836) and further in view of Arnaud et al (US 2003/0039621).

Sheehan does not teach the specified polymers, in that the second copolymer is different.

Holguin et al. explicitly teach that the copolymers of 2-hydroxyethyl and 4-hydroxybutyl acrylate can be used as a carrier for water resistant cosmetic products, the cosmetic compositions including such polymerase being easy to apply, non-occlusive, elastic and abrasion resistant.

Further, teaches poly-HEMA-HBA in a cosmetic composition as a consequence of their film-forming properties.

Arnaud et al. teach that overcoat lip composition comprising silicone modified fluorinated polymerase (as in instant claim 17) or polymeric vegetable oil (as in instant claim 16 and 23) are known in the field of cosmetic compositions (page 301). Additionally, oil thickeners or aqueous-phase thickeners are present in the composition (paragraph [0221]).

In view of the descriptions above, it appears obvious for one skilled in the art to substitute the copolymer taught by Holguin et al. with the newly developed copolymer of Sheehan which is already known for the analogous use in a cosmetic. Further, it would be obvious to include the teaching of Arnaud given that they are widely known to be common ingredients of cosmetic compositions.

With respect to claims 4-5, 22, the amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill to determine the optimal amount of each ingredient needed to achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, the optimization of ingredient amounts would have been obvious at the time of Applicant's invention.

With respect to claim 11, it is noted that *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to

Art Unit: 1614

be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

With respect to claim 6-7, 23, the specific polymeric thickener or the specific vegetable oil emollient. However, the determination of a chemically acceptable thickener and emollient that have the optimum efficacy is well within the purview of one skilled in the art. Accordingly, the artisan would have been motivated to determine optimally effective thickeners and emollients in order to get the maximum effect of the active agent. Moreover, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention and the prior art. If the prior art structure is capable of performing its intended use, then it meets the claim.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1614

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANNA PAGONAKIS whose telephone number is (571)270-3505. The examiner can normally be reached on Monday thru Thursday, 9am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AP

/Ardin Marschel/
Supervisory Patent Examiner, Art Unit 1614